

Application № 10/675,382  
Reply to Final Office Action of May 28, 2008

## **REMARKS / ARGUMENTS**

The present application includes pending claims 1-31, all of which have been rejected. Claims 1, 3, 7, 11, 13, 17, 21, 23 and 27 have been amended, to further clarify the claim and to further prosecution of the present application. The Applicant points out that support for the above listed claim amendments may be found in, for example, FIG. 1A and paragraph 54 of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-3, 6-9, 11-13, 16-19, 21-23, 26-29 and 31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sampsell (U.S. Patent No. 6,219,839, hereinafter, Sampsell).

Claims 4, 5 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sampsell in view of Griggs (U.S. Publication No. 2002/0053081, hereinafter, Griggs). The Applicant respectfully traverses these rejections at least based on the following remarks.

### **I. REJECTION UNDER 35 U.S.C. § 102**

MPEP 2131 states:

"[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP at 2131 (internal citation omitted). Furthermore, "[t]he identical invention must be shown in

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as complete detail as is contained in the ... claim." See *id.* (internal citation omitted).

**A. Sampsell Does Not Anticipate Claims 1-3, 6-9, 11-13, 16-19, 21-23, 26-29 and 31**

The Applicant now turns to the rejection of claims 1-3, 6-9, 11-13, 16-19, 21-23, 26-29 and 31 under 35 U.S.C. 102(b) as being anticipated by Sampsell (U.S. Patent No. 6,219,839, hereinafter, Sampsell).

**A(1). Rejection of Independent Claims 1, 11, and 21 under 35 U.S.C. § 102(a)**

With regard to the rejection of independent claim 1 under 102(b), the Applicant submits that Sampsell does not disclose or suggest at least the limitation of "constructing, at said first geographical location for display at a second geographic location, at least one display view indicating the availability of said detected available media," as recited by the Applicant in independent claim 1. The Final Office Action states the following:

"With respect to Claim 1, the claimed "A method for presenting available media for selection and playback on a television display, the method comprising: detecting, at a first geographic location, available media at a plurality of different storage locations within said first geographic location; and constructing at least one display indicating the availability of said detected available media" is met by Sampsell that teaches the use of a television receiver (12), in conjunction with a user interface, for the selection and playback of available media- whereby available media from a plurality of peripheral devices (VCR #1 14, VCR #2 16, DVD 20, LaserDisc 18) at a 1St location are detected and integrated into an electronic program guide/ electronic resource guide (EPG/ERG) via an electronic resources guide generator (Abstract, Figs.1 & 9; col.2,

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lines 19-27, col.3, lines 7-15, col.4, lines 5-16, col.5, lines 11-20, col.7, lines 11-18, col.9, lines 53-61)."

See Final Office Action at pages 2-3. The Applicant's claim 1 now reads "constructing, at said first geographical location for display at a second geographic location, at least one display view indicating the availability of said detected available media." The Applicant points out that Sampsell discloses an on-screen electronic resource guide (ERG) to display plural peripheral devices **at a single location** (see Fig. 1 & 9). In this regard, Sampsell does not disclose or suggest at least the limitation of "constructing, at said first geographical location **for display at a second** geographic **location**, at least one display view indicating the availability of said detected available media," as recited by the Applicant in independent claim 1.

Furthermore, with regard to the rejection of independent claim 1 under 102(b), the Applicant points out that with Sampsell's disclosure of displaying plurality of peripheral devices at a single location, Sampsell subsequently does not disclose or suggest at least the limitation of "communicating at least a portion of said available media from said first geographic location to said second geographic location," as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not anticipated by Sampsell and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

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**A(2). Rejection of Dependent Claims 2-3, 6-9, 12-13, 16-19, 22-23, 26-29 and 31**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(b) as being anticipated by Sampsell has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-3, 6-9, 12-13, 16-19, 22-23, 26-29 and 31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-3, 6-9, 12-13, 16-19, 22-23, 26-29 and 31.

**II. Rejection Under 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there

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must be a *suggestion or motivation in the reference* to do so" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

**The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.** If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

**A(1). Rejection of Dependent Claims 4, 5 and 10 Under 35 U.S.C. § 103(a)**

The Applicant turns to the rejection of claims 4, 5 and 10 by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Sampsell in view of Griggs (U.S. Publication No. 2002/0053081, hereinafter, Griggs).

Claims 4, 5 and 10 depend directly or indirectly on independent claim 1. Therefore, the Applicant submits that claims 4, 5 and 10 are allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1. In addition, Griggs does not overcome the deficiency of Sampsell.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 4, 5 and 10.

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**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Patent Agent at (312) 775-8093.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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